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| APPLICATION NO.  | FILING DATE        | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |           |               |                   |       |          |              |      |  |
|--|--------------------|--------------------------|---|------------------|-----------|---------------|-------------------|-------|----------|--------------|------|--|
| 10/530,465   | 04/05/2005         | Jennifer Albaneze-Walker | 21229Y-1  | 4867             |           |               |                   |       |          |              |      |  |
| 210<br>MERCK AND CO., INC<br>P O BOX 2000<br>RAHWAY, NJ 07065-0907 | 7590<br>05/25/2007 |                          | <table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">RAHMANI, NILOOFAR</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1625</td><td></td></tr></table> |                  | EXAMINER  |               | RAHMANI, NILOOFAR |       | ART UNIT | PAPER NUMBER | 1625 |  |
| EXAMINER   |                    |                          |   |                  |           |               |                   |       |          |              |      |  |
| RAHMANI, NILOOFAR  |                    |                          |   |                  |           |               |                   |       |          |              |      |  |
| ART UNIT   | PAPER NUMBER       |                          |   |                  |           |               |                   |       |          |              |      |  |
| 1625   |                    |                          |   |                  |           |               |                   |       |          |              |      |  |
|  |                    |                          | <table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>05/25/2007</td><td>PAPER</td></tr></table>   |                  | MAIL DATE | DELIVERY MODE | 05/25/2007        | PAPER |          |              |      |  |
| MAIL DATE  | DELIVERY MODE      |                          |   |                  |           |               |                   |       |          |              |      |  |
| 05/25/2007   | PAPER              |                          |   |                  |           |               |                   |       |          |              |      |  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/530,465

Applicant(s)

ALBANEZE-WALKER ET AL.

Examiner

Niloofer Rahmani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-18 are pending in the instant application.

2. ***Priority***

This application is file on 04/05/2005, which is a 371 of PCT/US03/36806, filed on 11/18/2003, which claims benefit of 60/428,315, foiled on 11/22/2002 and claims benefit of 60/472,655, filed on 05/22/2003.

3. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no reaction step to prepare compounds of formulas (IX and IXa) from the formulas (VIII or VIIIa). Therefore, there is a lack of step in the claims 1. Correction is required.

4. Claim 1 is rejected because there is no period at the end of the sentence. Correction is required.

5. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not describe in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-15 lack description of the claim i.e. " leaving group". Applicant disclosed the definition for leaving group in standard texts on page 4. The definition for "leaving group", which is incorporated of reference, is not proper. Therefore, the specification lacks description of " leaving group".

**6. Allowable Subject Matter**

Claims 16-18 are patentable over Guay et al., US 6,743,802. The reference teaches a process of purifying analogues compound, which has isopropyl N-substituent instead of the cyclopropyl N-substituent as the instant application. Therefore, the claims are free of prior art.

**7.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Mckenzie, can be reached on 571-

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272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

05/22/2007

SR



D. MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625